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EXAMINER

PRATT, EHRIN LARMONT

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte VARUN BHAGWAN,
TYRONE WILBERFORCE ANDRE GRANDISON,
DANIEL FERDERICK, and JAN HENDIK PIEPER

Appeal 2016-003790
Application 12/195,126
Technology Center 3600

Before ALLEN R. MACDONALD, CAROLYN D. THOMAS, and
NABEEL U. KHAN, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of claims 1, 2, 4–6, 8, 9, 11–14, 16–18, and 20, all the pending claims in the present application. Claims 3, 7, 10, 15, and 19 are canceled. *See* Claim Appendix. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We AFFIRM.

The present invention relates generally to determining preferences from information mashups. *See* Abstract.

Claim 1 is illustrative:

1. A computer-implemented method for determining preferences from cross-modality information mashups, the method comprising:

receiving by a computer a function for scoring two or more voting computing methods;

identifying by the computer the two or more vote computing methods, wherein each of the two or more vote computing methods are different combination techniques;

for each of the two or more vote computing methods, using by the computer the vote computing method to combine information on preferences into a combined list ranking the preferences, wherein the information comprises:

a first data from a first source, the first data includes a first list of preferences; and

a second data from a second source, the second data includes an unstructured data used by the computer to create a second list of preferences;

wherein the first data source and the second data source each have different modalities, the modalities include intentional, passive[,] and creative;

for each combined list, inputting by the computer the combined list into the function to compute a score corresponding to each of the voting computing methods; and

outputting from the computer the combined list of the vote computing method associated with the highest score.

Appellants appeal the following rejections:

R1. Claims 1, 2, 4–6, 8, 9, 11–14, 16–18, and 20 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter (Final Act. 2–3);

R2. Claims 1, 2, 5, 6, 8, 9, 11–14, 16–18, and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Urken (US 2002/0103695 A1,

Aug. 1, 2002) and Kirshenbaum (US 6,763,338 B2, July 13, 2004) (*id.* at 4–22); and

R3. Claim 4 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Urken, Kirshenbaum, and Clark (US 2006/0184483 A1, Aug. 17, 2006) (*id.* at 22–23).

We review the appealed rejections for error based upon the issues identified by Appellants, and in light of the arguments and evidence produced thereon. *Ex parte Frye*, 94 USPQ2d 1072, 1075 (BPAI 2010) (precedential).

ANALYSIS

Rejection under § 101

Issue 1: Did the Examiner err in finding that the claims are directed to non-statutory subject matter?

With respect to independent method claim 1, and similarly, computer-readable medium claim 8 and system claim 16, the Examiner finds these claims are directed to an abstract idea of “ranking preferences” which is “a fundamental business practice” (Final Act. 2). The Examiner adds that the claims are “similar to concepts relating to processes of organizing information found in ‘Digitech’ . . . organizing information through mathematical correlations” (Ans. 3), and “to mathematical algorithms, mathematical relationships, mathematical formulas, and calculations found in ‘In re Maucorps’” (*id.*). The Examiner further finds that “[t]he claims do not recite limitations that are ‘significantly more’ than the abstract idea because the claims do not recite an improvement to another technology or technical field” (Final Act. 2) and “includes using generic computer(s)

performing generic computer functions . . . [and] appending well-known, routine, and conventional activities” (Ans. 4).

Appellants contend “the Supreme Court seems to think that an idea is only a patent ineligible abstract idea if it is really, really old and well-established” (App. Br. 6) and “the claims are directed to significantly more than the abstract idea itself because the claims include specific limitations other than what is well-understood, routine and conventional” (*id.* at 6; *see also* Reply Br. 4). Appellants further contend that “Claim[s] 1, 8, and 16 ties the method to a specific structure or machine, i.e., a computer” (Reply Br. 4), the “Examiner has failed to review the totality of the evidence (i.e., the specification and claims) and articulate any evidence,” and the “modalities are tied to a particular technological environment (i.e., the online arena)” (*id.* at 6).

We disagree with Appellants’ contentions. Instead, we find that the Examiner has provided a sufficient response supported by a preponderance of evidence (Ans. 5–8). As such, we refer to, rely on, and adopt the Examiner’s findings and conclusions set forth in the Answer. Our discussions here will be limited to the following points of emphasis.

A patent may be obtained for “any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.” 35 U.S.C. § 101. The Supreme Court has held that this provision contains an important implicit exception: Laws of nature, natural phenomena, and abstract ideas are not patentable. *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014); *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972) (“Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not patentable, as they are

the basic tools of scientific and technological work.”). Notwithstanding, that a law of nature or an abstract idea, by itself, is not patentable, the application of these concepts may be deserving of patent protection. *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293-94 (2012). In *Mayo*, the Court stated that “to transform an unpatentable law of nature into a patent eligible *application* of such a law, one must do more than simply state the law of nature while adding the words ‘apply it.’” *Id.* at 1294 (citation omitted).

In *Alice*, the Court reaffirmed the framework set forth previously in *Mayo* “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of these concepts.” *Alice*, 134 S. Ct. at 2355. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* If the claims are directed to a patent-ineligible concept, then the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1298, 1297).

In other words, the second step is to “search for an ‘inventive concept’- *i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (brackets in original) (quoting *Mayo*, 132 S. Ct. at 1294). The prohibition against patenting an abstract idea “cannot be circumvented by attempting to limit the use of the formula to a particular technological environment or adding insignificant post-solution

activity.” *Bilski v. Kappos*, 561 U.S. 593, 610-11 (2010) (citation and internal quotation marks omitted). The Court in *Alice* noted that “[s]imply appending conventional steps, specified at a high level of generality,’ was not ‘enough’ [in *Mayo*] to supply an ‘inventive concept.’” *Alice*, 134 S. Ct. at 2357 (quoting *Mayo*, 132 S. Ct. at 1300, 1297, 1294).

Step one: Are the claims at issue directed to a patent-ineligible concept?

Claim 1 recites five steps: (a) receiving; (b) identifying; (c) combining; (d) inputting; and (e) outputting. Each of these steps involve information. A function is received and voting computing methods are identified. The vote computing methods are used to combine information on preferences into a combined list. The combined list is inputted into the function to compute a score. The combined list associated with the highest score is outputted. This is the essence of ranking preferences and organizing the information on preferences.

On the record before us, Appellants dispute that the claims are directed to an abstract idea, in essence because they believe the concept is not “really, really old and well-established” (App. Br. 6). We are not persuaded of error. For instance, information collection and analysis, including when limited to particular content, is within the realm of abstract ideas. *See, e.g., Elec. Power Grp. LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (holding that “collecting information, analyzing it, and displaying certain results of the collection and analysis” are “a familiar class of claims ‘directed to’ a patent-ineligible concept”); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016); *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1349 (Fed. Cir. 2015);

Digitech Image Techs., LLC v. Elecs. for Imaging, Inc., 758 F.3d 1344, 1351 (Fed. Cir. 2014); and *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011). Further, claim 1 employs little more than the manipulation of information through a long prevalent social welfare function (SWF) construct that combines data from various sources (*see* Spec. ¶¶ 19 and 43–49). Such processes have been found to be abstract ideas. *See Digitech*, 758 F.3d at 1351 (quoting *Parker v. Flook*, 437 U.S. 584, 595 (1978)); *see also In re Maucorps*, 609 F.2d 481, 485-86 (CCPA 1979) (holding a method of “optimizing the organization of sales representatives” unpatentable), *cited in CyberSource*, 654 F.3d at 1371 n.2.

Because the claims are directed to mathematical manipulations, an abstract idea, the claims at issue are directed to patent-ineligible subject matter.

Step two: Is there something else in the claims that ensures that they are directed to significantly more than a patent-ineligible concept?

To establish a *prima facie* case, the Examiner must next identify all of the additional elements in each claim and explain why these elements, individually or collectively, do not add significantly more than the abstract idea. Here, the Examiner finds that the claims “includes using generic computer(s) performing generic computer functions . . . [and] appending well-known, routine, and conventional activities” (Ans. 4). We agree with the Examiner.

“A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Alice*, 134 S. Ct. at 2357 (brackets in

original) (quoting *Mayo*, 132 S. Ct. at 1297). The prohibition against patenting an abstract idea “cannot be circumvented by attempting to limit the use of the formula to a particular technological environment or adding insignificant post-solution activity.” *Bilski v. Kappos*, 561 U.S. at 610-11 (citation and internal quotation marks omitted). The recitations in claim 1 pertaining to “a computer” are analogous to the recitation of a conventional “computer” discussed in *Alice*.

Additionally, as recognized by the Federal Circuit in *Ulramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014), *Bilski*’s “machine-or-transformation” (MoT) test can also provide a ““useful clue”” in the second step of the *Alice* framework. *See Bilski*, 561 U.S. at 611. Under *Bilski*’s MoT test, a claimed process can be considered patent-eligible under § 101 if: (1) “it is tied to a particular machine or apparatus”; or (2) “it transforms a particular article into a different state or thing.” *Bilski*, 545 F.3d 943, 954 (Fed. Cir. 2008) (citing *Gottschalk*, 409 U.S. at 70, 93 S. Ct. 253).

Here, Appellants merely contend that “Claim[s] 1, 8, and 16 ties the method to a specific structure or machine, i.e., a computer” (Reply Br. 4), the “Examiner has failed to review the totality of the evidence (i.e.,] the specification and claims) and articulate any evidence,” (*id.* at 5) and the “modalities are tied to a particular technological environment (i.e.,] the online arena)” (*id.* at 6). In other words, Appellants merely contend that method claim 1 and its corresponding medium and system claims 8 and 16 are tied to a computer, but do not argue that the claims are involved in any

type of transformation of any particular article.¹ Claim 1 merely recites that each step is “computer-implemented” and/or performed “by a computer” (*see* claim1). We agree with the Examiner that claim 1 simply incorporates a generic component, i.e., a computing device, into the method to perform the abstract concept of ranking preferences.

As recognized by the Supreme Court, “the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention.” *See Alice*, 134 S. Ct. at 2359 (concluding claims “simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer” not patent eligible); *see also Ultramercial*, 772 F.3d at 715–16 (claims merely reciting abstract idea of using advertising as currency as applied to particular technological environment of the Internet not patent eligible); *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (claims reciting “generalized software components arranged to implement an abstract concept [of generating insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] on a computer” not patent eligible); and *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) (“[s]imply adding a ‘computer aided’ limitation to a claim covering an abstract concept, without more, is insufficient to render [a] claim patent eligible” (internal citation omitted)).

Limiting such an abstract concept of “ranking preferences” to generic components, such as a computing device, does not make the abstract concept patent-eligible under 35 U.S.C. § 101. Because Appellants’ independent

¹ *Alice* also confirmed that if a patent’s systems claims are no different in substance from its method claims, they will rise and fall together. 134 S. Ct. at 2360. The same was true of the *Alice* patent’s media claims. *Id.*

claims 1, 8, and 16 are directed to a patent-ineligible abstract concept and do not recite something “significantly more” under the second prong of the *Alice* analysis, we sustain the Examiner’s rejection of these claims as well as respective dependent claims 2, 4–6, 9, 11–14, 17, 18, and 20 under 35 U.S.C. § 101 as being directed to non-statutory subject matter in light of *Alice* and its progeny.

For the foregoing reasons, Appellants’ contentions are unpersuasive as to error in the rejection under 35 U.S.C. § 101.

Rejections under § 103(a)

Issue 2: Did the Examiner err in finding that Urken teaches or suggests voting computing methods, as set forth in claim 1?

Appellants contend that “Urken does not teach creating multiple combined lists each based on *vote computing methods* and then inputting those lists into a function to score each of the combined lists and outputting the combined list with the highest score” (App. Br. 8). Appellants further contend that in “the Final Office Action mailed 8/23/2013, [the] Examiner acknowledges that Kirshenbaum fails to disclose, ‘for each combined list, inputting . . . and outputting . . .’” (*id.* at 9).

As an initial matter, we note that the Final Office Action mailed 8/23/2013, referenced by Appellants, is superseded by the Final Office Action mailed 2/05/2015 in which the Examiner does not acknowledge that Kirshenbaum fails to disclose “for each combined list, inputting . . . and outputting . . .” Therefore, Appellants contention pertaining thereto is moot.

As for Appellants contention that Urken does not teach creating multiple combined lists and inputting and outputting the same as claimed

(*see* App. Br. 8), we find Appellants have failed to present *substantive* arguments and supporting *evidence* persuasive of Examiner error regarding the aforementioned disputed limitation. *See In re Lovin*, 652 F.3d 1349, 1357 (Fed. Cir. 2011) (“we hold that the Board reasonably interpreted Rule 41.37 to require more substantive arguments in an appeal brief than a mere recitation of the claim elements and a naked assertion that the corresponding elements were not found in the prior art.”). We decline to examine the claims *sua sponte*, looking for distinctions over the prior art. *Cf. In re Baxter Travenol Labs.*, 952 F.2d 388, 391 (Fed. Cir. 1991) (“It is not the function of this court to examine the claims in greater detail than argued by an appellant, looking for [patentable] distinctions over the prior art.”). *See also Ex parte Belinne*, No. 2009-004693, 2009 WL 2477843 at *3-4 (BPAI Aug. 10, 2009) (informative).

Here, Appellants merely point out what claim 1 recites, followed by what Urken discloses in paragraphs 78–80 and 124–126 (*see* App. Br. 7–9) without providing any meaningful analysis that *explains why* the Examiner erred, i.e., the Examiner cites at least paragraphs [76–81] and [124–129] for teaching/suggesting the aforementioned limitations (*see* Final Act. 4–6) and Appellants merely reiterates the same to us. Also, Appellants fail to explain why the Examiner has not shown the Urken teaches “vote computing methods.” A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim. *See* 37 C.F.R. § 41.37(c)(1)(vii). We note that arguments which Appellants could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. Therefore, Appellants’ arguments are unpersuasive.

Accordingly, we sustain the Examiner's rejection of claim 1. Appellants' arguments regarding the Examiner's rejection of independent claims 8 and 16 rely on the same arguments as for claim 1, and Appellants do not argue separate patentability for the dependent claims. *See* App. Br. 7–10. We, therefore, also sustain the Examiner's rejection of claims 2, 4–6, 8, 9, 11–14, 16–18, and 20.

DECISION

We affirm the Examiner's § 101 and § 103(a) rejections R1–R3.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED